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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/04/2008

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EXAMINER

LASTRA, DANIEL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/964,600	Applicant(s) KAWAHARA ET AL.	
	Examiner DANIEL LASTRA	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 14, 16, 19, 26, 28, 29, 33, 34 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14, 16, 19, 26, 28, 29, 33, 34 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 14, 16, 19, 26, 29, 29, 33-34 and 37 have been examined. Application 09/964,600 (PORTABLE TERMINAL DEVICE FOR PROVIDING AND OBTAINING ADVERTISEMENT INFORMATION, ADVERTISEMENT PROVIDING METHOD, ADVERTISEMENT OBTAINING METHOD, ADVERTISEMENT DISTRIBUTING METHOD AND PROGRAM THEREFOR) has a filing date 09/28/2001 and foreign priority 06/04/2001.

Response to Amendment

2. In response to Final Rejection filed 01/23/2008, the Applicant filed an RCE on 05/23/2008, which amended claims 1, 14, 26, 28, 33, 37 and cancel claims 22, 27 and 32.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22, 33 and 37 are rejected under 35 U.S.C. 101 because said claims are directed to non-statutory subject matter. Claim 22 is recited as an apparatus claim however, said claim is claiming functional descriptive material (i.e. software) as a "searching unit" and a "delivering unit" are defined in Applicant's specification as software. Also, claim 33 is claiming a person (i.e. an advertisement medium person") in an apparatus claim (see MPEP 2105). With respect to claim 37, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175,

Art Unit: 3688

184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claim 37 fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 14, 16, 19, 26, 29, 29, 33-34 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 33 is defined as system claim however, said claims is indefinite as is claiming software. Claim 37 is indefinite as is a method claim not tied to an apparatus. Claims 1, 14 and 37 are indefinite because presents a problem of antecedent basis with the limitation "the received goods search condition". Furthermore claims 1, 14, 16, 19, 26, 29, 29, 33-34 and 37 are indefinite because the limitation "*user identifying information of the plurality of the advertisement medium persons is received a plurality of times, the user identifying information which has been contained every time in the received user identifying, information is determined, the advertising information of the goods*

Art Unit: 3688

conforming, to the received goods search conditions among the goods associated with the advertisement medium person corresponding to the determined user identifying information is found" is indefinite as said limitation does not mention where said user identifying information of the plurality of the advertisement medium persons is received. Furthermore, the limitation "the user identifying information which has been contained every time in the received user identifying information is determined" is indefinite because it is not clear if "the received user identifying information" is an apparatus or a person?) and also is not clear how user identifying information is contained in user identifying information? Furthermore, the limitation "user identifying information of the plurality of the advertisement medium persons is received a plurality of times" would be interpreted as sending identifying information about all persons that have advertisements in their portable devices. For purpose of art rejection the limitation the limitation *"the advertising information of the goods conforming, to the received goods search conditions among the goods associated with the advertisement medium person corresponding to the determined user identifying information is found"* would be interpreted as meaning finding advertisements associated with an advertisement medium person.

Claims 1, 14 and 37 recite the limitation "the received goods search conditions". Claims 1, 14, 26, 28, 33 and 37 recite "the plurality of the advertisement medium persons. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14, 16, 19, 26, 28, 29, 33-34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Pradhan (US 2002/0160759).

As per claim 1, Pradhan teaches:

An advertisement distributing method of a server providing advertising information, comprising:

receiving user-specified information about an advertisement medium person having goods on or with and a retrieval condition of goods from a portable terminal device of a consumer, said receiving being at the server connected with said portable terminal device of the consumer through a network (see paragraphs 45-49; 90 and 120);

specifying the advertisement medium person corresponding to the received user-specified information among user specified information of a plurality of advertisement medium persons stored in a storage device in advance, and retrieving, from the

Art Unit: 3688

advertising information of a plurality of goods stored in the storage device, advertising information of goods corresponding to the retrieval condition among goods associated with the specified advertisement medium person, said specifying and said retrieving being executed by the server (see paragraphs 48-50; 105-108, 120-123); and

distributing the advertising information obtained by said retrieving to the portable terminal device of the consumer via the network (see paragraph 7);

user identifying information of the plurality of the advertisement medium persons is received a plurality of times (see paragraph 114 "there are a plurality of advertisements accepted by a consumer device"),

the user identifying information which has been contained every time in the received user identifying information is determined, the advertising information of the goods conforming to the received goods search conditions among the goods associated with the advertisement medium person corresponding to the determined user identifying information is found (see figure 8 "a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisers portable device which transmitted the advertisements (see paragraph 105), and

wherein the advertising distributing method is used with an advertising providing system having a portable terminal device of the advertisement medium person having the goods on or with (see paragraph 106, 123), and the portable terminal device of the consumer receiving advertising information connected to the server via the network (see paragraph 7).

As per claim 14, Pradhan teaches:

A computer readable medium having a program stored therein for causing a computer to execute operation comprising:

receiving user-specified information about an advertisement medium person having goods on or with a retrieval condition of goods from a portable terminal device of a consumer, said receiving being at the server connected with said portable terminal device of the consumer through a network (see paragraphs 45-50; 90 and 120);

specifying the advertisement medium person corresponding to the received user-specified information among user specified information of a plurality of advertisement medium persons stored in a storage device in advance, and retrieving, from the advertising information of a plurality of goods stored in the storage device, advertising information of goods corresponding to the retrieval condition among goods associated with the specified advertisement medium person, said specifying and said retrieving being executed by the server (see paragraphs 105-108 and 120-123); and

distributing the advertising information obtained by said retrieving to the portable terminal device of the consumer via the network (see figure 8);

user identifying information of the plurality of the advertisement medium persons is received a plurality of times (see paragraph 114 “there are a plurality of advertisements accepted by a consumer device”),

the user identifying information which has been contained every time in the received user identifying information is determined, the advertising information of the goods conforming to the received goods search conditions among the goods associated

Art Unit: 3688

with the advertisement medium person corresponding to the determined user identifying information is found (see figure 8 " a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisers portable device which transmitted the advertisements (see paragraph 105), and

wherein the advertising distributing method is used with an advertising providing system having a portable terminal device of the advertisement medium person having the goods on or with (see paragraphs 106 and 123), and the portable terminal device of the consumer receiving advertising information connected to the server via the network (see paragraph 7).

As per claim 16, Pradhan teaches:

The advertisement distributing method of claim 1, comprising:

receiving a user entry of the person having the goods on or with (see paragraph 99) and

distributing the advertising information about the goods obtained by said retrieving to a portable terminal device of person (see paragraph 99), and

requesting transmission of the advertising information or transmitting the advertising information between the portable terminal device of the person and the portable terminal device of the consumer (see figure 1).

As per claim 19, Pradhan teaches:

The method according to claim 1, wherein said user information comprises user-specified information, information designating whether or not an advertisement can be

Art Unit: 3688

distributed, a term of distribution, and information designating access destination for advertising information (see paragraph 7).

As per claim 26, Pradhan teaches:

An advertising information delivery method for use with a server device, comprising:

receiving from a portable terminal device of a consumer via a network a reviewing request, which contains user identifying information of person having goods on or with said persons and goods search conditions (see figure 1 and paragraph 125);

determining, based on information about the person, an advertisement medium person having user identification information, corresponding to the received user identifying information (see paragraph 120),

finding from the storage unit, advertising information of goods conforming to the received goods search conditions among the goods associated with the advertisement medium person (see paragraph 120); and

delivering the found advertising information to the portable terminal device of the consumer (see paragraph 115).

user identifying information of the plurality of said persons is received a plurality of times (see paragraph 114 “there are a plurality of advertisements accepted by a consumer device”),

the user identifying information which has been contained every time in the received user identifying information is determined, the advertising information of the goods conforming to the received goods search conditions among the goods associated

Art Unit: 3688

with said person corresponding to the determined user identifying information is found
(see figure 8 " a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisers portable device which transmitted the advertisements (see paragraph 105), and

As per claim 28, Pradhan teaches:

An advertising information acquiring method for enabling a portable terminal device of a consumer to acquire advertising information from a server device via a network, comprising:

receiving from other portable terminal devices, which are carried by persons having goods on or with, user identifying information of the persons (see figure 1 and paragraph 106)

obtaining an input of the consumer specifying goods search conditions (see paragraph 114);

transmitting to the server device, a reviewing request including both the user identifying information and the goods search conditions (see paragraphs 114);

specifying, by the server device, an advertisement medium person corresponding to the received user identifying information of said persons stored in advance, and retrieving advertising information of goods corresponding to the goods search conditions (see paragraph 114);

acquiring the advertising information of goods retrieved by the server device, said advertising information of goods corresponding to said goods search conditions (see paragraphs 45-49) and

distributing the advertising information obtained by said retrieving to the portable terminal device of the consumer via the network (see paragraph 115),

user identifying information of the plurality of the advertisement medium persons is received a plurality of times (see paragraph 114 "there are a plurality of advertisements accepted by a consumer device"),

the user identifying information which has been contained every time in the received user identifying information is determined, the advertising information of the goods conforming to the received goods search conditions among the goods associated with the advertisement medium person corresponding to the determined user identifying information is found (see figure 8 "a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisers portable device which transmitted the advertisements (see paragraph 105), and

wherein the advertising information of goods corresponds to an advertisement medium person who corresponds to said user identifying information (see paragraphs 105-107).

As per claim 29, Pradhan teaches:

the user identifying information is received from the portable terminal devices a plurality of times (see paragraph 114); and

the user identifying information and goods search conditions received a plurality of times are transmitted to the server device to determine said one or more said persons (see paragraphs 114-115).

As per claim 33, Pradhan teaches:

A server device for delivering advertising information of goods to a portable terminal device of a consumer via a network, comprising:

a receiving unit receiving from the portable terminal device of the consumer, a reviewing request, includes user identifying information of persons having goods on or with and goods search conditions (see paragraphs 105-106);

a searching unit determining, from information stored in a storage unit and containing user identifying information of plurality of persons (see paragraph 114), an advertisement medium person corresponding to the received user identifying information, and finding, from the storage unit, advertising information of the goods conforming to the received goods search conditions among the goods associated with the determined person (see paragraph 114); and

a delivery unit delivering the found advertising information to the portable terminal device of the consumer via a network (see paragraph 115).

user identifying information of the plurality of said persons is received a plurality of times (see paragraph 114 “there are a plurality of advertisements accepted by a consumer device”),

the user identifying information which has been contained every time in the received user identifying information is determined, the advertising information of the

Art Unit: 3688

goods conforming to the received goods search conditions among the goods associated with said person corresponding to the determined user identifying information is found (see figure 8 " a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisers portable device which transmitted the advertisements (see paragraph 105), and

As per claim 34, Pradhan teaches:

The server advice according to claim 33, wherein:

the receiver unit receives the user identifying information every time when the user identifying information being received by the portable terminal device of the consumer a plurality of times (see paragraph 120); and

the searching unit determines the user identifying information contained every time among the user identifying information received a plurality of times by the receiver unit and finding the advertising information of the goods conforming to the received goods search conditions among the goods associated with said person corresponding to the determined the user identifying information (see paragraphs 114-115).

As per claim 37, Pradhan teaches:

A method of providing advertisement, comprising:

storing a predetermined advertisement on a portable terminal of a first user, said predetermined advertisement being transmitted from a provider of a product and identifying the product (see paragraph 114);

receiving user-specified information of the first user including a retrieval condition from a second user (see paragraph 7); and

retrieving said advertisement from the portable terminal of the first user responsive to receipt of the user-specified information and said retrieval condition from the second user and transmitting said advertisement to a device of the second user, thereby enabling the first user to provide said advertisement on behalf of the provider of the product (see paragraphs 105-106).

user identifying information of the plurality of said persons is received a plurality of times (see paragraph 114 "there are a plurality of advertisements accepted by a consumer device"),

the user identifying information which has been contained every time in the received user identifying information is determined, the advertising information of the goods conforming to the received goods search conditions among the goods associated with said person corresponding to the determined user identifying information is found (see figure 8 "a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisers portable device which transmitted the advertisements (see paragraph 105).

Response to Arguments

6. Applicant's arguments filed 07/17/2008 have been fully considered but they are not persuasive. The Applicant argues that Pradhan does not teach "user identifying information of the plurality of the advertisement medium persons is received a plurality

Art Unit: 3688

of times and the advertising information of the goods conforming to the received goods search conditions among the goods associated with the advertisement medium person corresponding to the determined user identifying information is found. The Examiner answers that Pradhan teaches in figure 8 and paragraph 105 that a plurality of advertisements from advertisements medium persons are found in the consumer's portable device in order that the consumer communicates with the advertisement medium person devices which transmitted the advertisements. Therefore, contrary to Applicant's argument, Pradhan teaches Applicant's claimed limitation.

The Applicant argues that Pradhan does not provide enabling disclosure pertaining to the claimed feature of receiving user-specified information about an advertisement medium person. The Examiner answers that Pradhan teaches providing to a consumer advertiser information about how to contact an advertiser (i.e. advertisement medium person) (see paragraph 114). Therefore, contrary to Applicant's argument, Pradhan teaches Applicant's claimed invention and is enabling.

The Applicant argues that the limitation "advertising information of goods corresponding to the retrieval condition among goods associated with the specified advertisement medium person" means that advertising information is retrieved based on information of the advertisement medium person while the advertising information may be sent to any user. The Examiner answers that the Examiner is not reading said interpretation from the claims as the claims are indefinite due to antecedent problems and lack of structure (i.e. apparatus) in the claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Art Unit 3688
September 1, 2008